

The opinion in support of the decision being entered today was **not** written for publication and is not binding precedent of the Board.

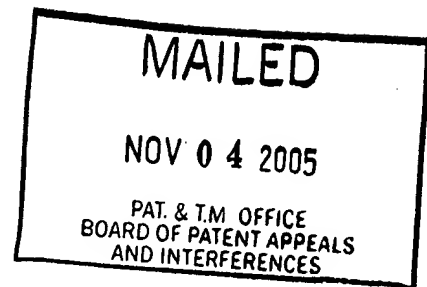
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte Pradeep Bahl, Ramesh K. Vyaghrapuri,
Florin Teodorescu and Shirish R. Koti

Appeal No. 2005-1807
Application No. 09/587,204

HEARD: October 19, 2005



Before DIXON, GROSS, and BLANKENSHIP, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-36, 38, and 39, which are all of the claims pending in this application.

We **AFFIRM-IN-PART**.

BACKGROUND

Appellants' invention relates to a system and method for automatic detection and configuration of network parameters. An understanding of the invention can be derived from a reading of exemplary claims 1 and 26 , which are reproduced below. Claims 1 and 26 are representative of the various groupings which we will address in light of appellants' election to group all claims as standing or falling together. (Brief at page 3.)

1. A system that automates detection and configuration of network parameters, comprising:

a first computer system that communicate with a network; and

at least a second computer system that provides network information, the first computer system queries the network and receives the network information from the at least a second computer system before a network identification has been established for the first computer system and the first computer configures a network interface based on modifications to at least one stored configuration and associated with the received network information.

26. A system that automates detection and configuration of network parameters, comprising:

a first computer system with a network interface;

a storage that stores at least one configuration associated with a network;

at least a second computer system that provides network information to the first computer system; and

A Multiple Internet Protocol Configurations (MIPC) service that matches the at least one configuration with a network identification associated with the network information, wherein the first computer configures the network interface based on the matched configuration.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Romohr	5,596,723	Jan. 21, 1997
LeMaire et al. (LeMaire)	5,99,530	Dec. 7, 1999
Cheston et al. (Cheston)	6,412,025	Jun. 25, 2002

Claims 1-6, 14-18, 22-34, and 38 stand rejected under 35 U.S.C. § 102 as being anticipated by Cheston. Claims 7-11, 35, and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cheston in view of LeMaire. Claims 12, 13, 19-21, and 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cheston in view of Romohr.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Jul. 23, 2004) for the examiner's reasoning in support of the rejections, and to the brief (filed May 13, 2004) and reply brief (filed Aug. 25, 2004) for appellants' argument thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Only those arguments actually made by appellants have been considered in this decision. Arguments that appellants could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellants [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. We note that appellants have elected to group ALL claims as standing or falling together at page 3 of the Brief, but appellants have also provided separate headings for each of the independent claims. In fairness to appellants, we will address appellants' arguments as to each of separate independent claims as a separate grouping.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman**

v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842 (Fed. Cir. 1984).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d at 633, 2 USPQ2d at 1054 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see **Hazani v. Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that

the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d at 772, 218 USPQ at 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

With respect to independent claim 1, the examiner maintains that Cheston teaches the invention recited in independent claim 1 (Answer at page 4-5 and 16-17.) We agree with the examiner and find that the stored table of terminals that is updated when a terminal is removed teaches a modification of a stored configuration since the entire table is not regenerated, but merely changed to reflect the new locations of those terminals which have been moved and require rerouting of communications.

We find the examiner's interpretation and position to be a reasonable one with respect to the language of independent claim 1. Appellants argue that in contrast to Cheston, the claimed invention recites modifying at least one stored configuration associated with the received network information. Appellants argue that Cheston is silent regarding employing modified stored configurations as recited in the subject claim. (Brief at page 4.) We disagree with appellants. The examiner interprets modifying the tables as modifying the stored network configuration and appellants maintain that the two are not "synonymous." (Brief at page 5.) As stated above, we find that modifying the stored configuration of the network in the already stored table to teach "the first computer configures a network interface based on modifications to at least one stored configuration and associated with the received network information."

Here, we note that the limitation of “at least one stored configuration” allows the examiner’s interpretation to be a reasonable interpretation and we will sustain the rejection of independent claim 1 and its dependent claims 2-6 and 14-16 since appellants have not shown error therein or adequately rebutted the *prima facie* case of anticipation.

With respect to independent claim 17, the examiner maintains that although Cheston does not expressly teach a delay timer with a delay time based on a value of an associated address, that there exists a timer associated with each address and that

in a conventional computer system, when a query is sent to a network, there exists a delay timer that specifies a period of time from when the query is sent until it is received. Also, although Cheston et al. do not expressly teach a delay timer with a delay time based on a value of an associated address, he teaches configuring network parameter using DHCP [Dynamic Host Connection Program]. It is well known in the art of computer networking that for every entry in the DHCP, there exists a timer associated with each address.

(Answer at page 17.)

While appellants do not dispute the examiner assertions, appellants argue that the examiner has not addressed the language of the claim wherein the claim recites “a delay timer with a delay time based on a value of an associated address.” We agree with appellants and do not find that Cheston teaches the claimed delay timer and the examiner has not made the requisite showing for a finding of inherency of the delay timer as claimed. Therefore, we cannot sustain the rejection of independent claim 17 and its dependent claims 18, 22 and 23.

With respect to independent claim 24, appellants rely upon the same argument as with claim 1 which we did not find persuasive above. Similarly, we do not find this argument persuasive with respect to claim 24 and 25, and we will sustain the rejection of these claims.

With respect to independent claim 26, appellants argue that the claim recites Multiple Internet Protocol Configurations (MIPC) service that matches at least one network configuration stored within the first computer with a network identification associated with the information received from a second computer wherein the match facilitates the first computer in configuring a network interface. Appellants argue that Cheston does not teach or suggest these claimed aspects. (Brief at page 6.) We agree with appellants and find that Cheston does not teach the claimed limitations and the examiner has not made the requisite showing for a finding of inherency of the claimed limitations. Therefore, we cannot sustain the rejection of independent claim 26 and dependent claims 27-33.

With respect to independent claim 34, appellants argue that Cheston does not teach the claimed limitations and Cheston “does not contemplate determining a third computer system network configuration from at least one of a first computer system and a second computer system as recited.” (Reply Brief at page 7.) We agree with appellants, and further find that Cheston also does not expressly teach “the first

computer system configures the network interface by determining a network identification associated with the network information and matching the at least one configuration with the network identification” since the examiner has not shown any matching of a network configuration. Therefore, we cannot sustain the rejection of independent claim 34 and its dependent claim 38.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103

must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir.

1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

First we note that appellants elected to group claims 7-13 as standing with the independent claim 1. Therefore we group these claims with independent claim 1 and sustain the rejection thereto.

Second, we do not find, and the examiner has not identified how the teachings of LeMaire or Romohr remedy the above noted deficiencies with respect to claims 17 and 34. Therefore, we cannot sustain the rejection of claims 19-21, and 35-36, and 39.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6, 14-16, 24 and 25 under 35 U.S.C. § 102 is AFFIRMED, the decision of the examiner to reject claims 17, 18, 22, 23, 26 - 34 and 38 under 35 U.S.C. § 102 is REVERSED, the decision of the examiner to reject claims 7-13 under 35 U.S.C. § 103 is AFFIRMED, and the decision of the examiner to reject claims 19-21, 35-36, and 39 under 35 U.S.C. § 103 is REVERSED.

Appeal No. 2005-1807
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JOSEPH L. DIXON

JOSEPH L. DIXON
Administrative Patent Judge

Anita Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Howard B. Blankenship

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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